

REMARKS

Claims 1-15 remain pending in this application

Claims 1, 5-7, and 9-11 are rejected under 35 U.S.C. § 102(b) as being anticipated by Wolf (U.S. Patent No. 4,835,002), which is characterized as disclosing microemulsions of oil in water and alcohol. Applicants respectfully traverse this rejection.

Claim 1 of the present application recites an edible, clear, high oil loaded, thermodynamically stable oil-in-water microemulsion comprising:

- (a) at least 30% of oil;
- (b) 1 to 30% of a non-ionic surfactant system having a hydrophilic lipophilic balance, HLB, comprised between 9 and 18;
- (c) *less than 20% of co-solvent*; and
- (d) at least 30% of water.

The co-solvent, when present, resides in the aqueous phase and is typically an alcohol selected from the group consisting of propylene glycol, ethanol, mono and disaccharide sugars and sugar alcohols such as sorbitol, xylitol and mannitol.

In contrast, the microemulsions disclosed in Wolf are formed using the following components:

- (a) about 0.01 to 45% of oil, preferably about 1 to 15%;
 - (b) about 0.1 to 30% of a surfactant composition, preferably about 1 to 30%;
 - (c) *about 20 to 95% of a polyol* (i.e., a co-solvent) and preferably about 25 to 80%;
- and
- (d) the balance being water. (col. 7, lines 53-59)

As stated in the description, the alcohol or polyol used in the Wolf compositions do not function as co-surfactant; it is only essentially present in the outer water phase and not in the inner oil phase of the microemulsions (col. 4, lines 37-47). In other words, the alcohol is a "co-solvent" as is commonly referred in the art.

Wolf thus differs from the present invention in that its emulsions comprise more than 20% of a co-solvent, namely an alcohol. As noted in Wolf, alcohols suitable for this purpose are preferentially soluble in water (col. 4, line 23), and the last step of the method for forming the microemulsions consists of adding "enough of the alcohol to achieve the microemulsion stage, as evidenced by the clarity, to the naked eye, of the resulting system" (col. 7, lines 37-39). Wolf further states that "Prior to the addition of the full amount of alcohol needed to achieve such clarity, the mixture of [surfactant and oil] will have a cloudy and turbid

appearance" (column 7, lines 39-42). It is clear then that the full amount of alcohol, constituting at least 20% of the composition, is essential in obtaining a clear microemulsion according to Wolf. Thus, the prior art teaches the minimum amount of co-solvent required to obtain a microemulsion is at least 20%, but there is no teaching of how to obtain a clear emulsion using less than that amount, nor is there any disclosure or suggestion that less than 20% alcohol could be used to obtain a clear product.

In contrast, one of the novel features of the present invention is that its microemulsion may include a high amount of oil and be stable at high temperature, even with a low ratio of co-solvent relative to surfactant. In specifying that using less than the minimum amount of alcohol required would lead to a cloudy and turbid product, Wolf does not teach, disclose or suggest that a clear, high oil loaded, thermodynamically stable oil-in-water microemulsion can be obtained with less than 20% alcohol. Since Wolf does not teach each and every element of the present claims, Applicants respectfully submit that the prior art does not anticipate the present claims. Accordingly, the § 102(b) rejection should be withdrawn.

Similarly, Wolf does not render the present claims obvious. The Examiner rejects claims 1 and 3-14 under 35 U.S.C. § 103(a) as being unpatentable over Wolf, but because of the significant difference between the present invention and the Wolf composition, such as the amount of co-solvent used to produce a clear microemulsion, Wolf cannot render these claims obvious. In fact, by disclosing that using less than the minimum amount of alcohol required would lead to a cloudy and turbid product, Wolf teaches away from the present invention. A person skilled in the art, confronted with the problem of providing a clear and stable microemulsion, would have no motivation to modify Wolf to prepare a product as claimed in the present invention.

The Examiner further states that, although claims 3 and 4 appear to differ from Wolf in that an antioxidant, such as a tocopherol, is used, using an antioxidant in any food product would have been an obvious way to enhance the storage life of a food product and to fortify a food product. As to claim 13, the Examiner states that flavor enhancement would be expected from the inclusion of a flavor or an added flavor to the beverage product of Wolf, and, as to claim 8, that selecting the specific alcohols of claim 8 for use in Wolf would have been obvious to a skilled artisan with respect to the use of sugar alcohols. However, these rejections are rendered moot because, as explained above, the microemulsion of claim 1 is fundamentally different from the Wolf composition and is not obvious in light of Wolf. Hence, § 103 rejection should also be withdrawn.

Lastly, the Examiner states that claims 2 and 15 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form. However, because the independent claims are allowable under § 102 and § 103, claims 2 and 15 do not need to be re-written in independent form.

In view of the foregoing, it is believed that the entire application is now in condition for allowance, early notification of such would be appreciated. Should the Examiner not agree, a personal or telephonic interview is respectfully requested to discuss any remaining issues in order to expedite the eventual allowance of the claims.

Respectfully submitted,

Date

12/15/03

Allan A. Fanucci 30,256
(Reg. No.)

WINSTON & STRAWN LLP
CUSTOMER NO. 28765
(212) 294-3311